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09/663,543	09/15/2000	Hideo Kawahara	1232-4647	3853
27123	7590	01/13/2005	EXAMINER	
MORGAN & FINNEGAN, L.L.P. 3 WORLD FINANCIAL CENTER NEW YORK, NY 10281-2101			JERABEK, KELLY L	
			ART UNIT	PAPER NUMBER
			2612	

DATE MAILED: 01/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/663,543

Applicant(s)

KAWAHARA, HIDEO

Examiner

Kelly L. Jerabek

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 10 August 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-17, 20-26 and 29-45 is/are pending in the application.
- 4a) Of the above claim(s) 8-13, 20, 29-31, 33, 35, 37, 39, 41, and 43-45 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3, 5, 6, 14-17, 21, 22, 24-26, 32, 34, 38, 40 and 42 is/are rejected.
- 7) ☒ Claim(s) 4, 7, and 23 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Arguments***

Applicant's arguments with respect to claims 1-7, 14-17, 21-26, 32, 34, 38, 40, and 42 have been considered but are moot in view of the new ground(s) of rejection.

### ***Claim Objections***

Claim 23 objected to because of the following informalities: Claim 23 recites the limitation "said predetermined position" on page 7, lines 11-12. There is insufficient antecedent basis for this limitation in the claim.

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

**Claims 17 and 26 rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject**

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matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Amended claims 1 and 21 require that the optical transparent member has a focal length within a predetermined range of focal length (specification: pages 14-22; figures 1-4). Claims 17 and 26 require that the optical transparent member comprises a filter (specification: page 44). The original disclosure teaches that an image may be deteriorated due to the movement of an optical transparent member which passes an optical image of an object, such as deterioration of an image due to the focus position and a filter (specification: page 44). The amended claims now state that a predetermined control is performed when the optical transparent member has a focal length within a predetermined range of focal length and that the optical transparent member is a filter (Claims 17 and 26). However, the original disclosure teaches that a filter is used as the optical transparent member in cases in which an image is deteriorated due to movement of an optical transparent member which passes an optical image of an object, not in cases in which resolution is deteriorated corresponding to the focal length of the optical transparent member.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

**Claims 1-3, 5-6, 15-16, 21-22, 24-25, 32, 34, 38, 40, and 42 rejected under 35**

**U.S.C. 102(e) as being anticipated by Dunton et al. US 2001/0050712.**

Re claim 1, Dunton discloses in figure 1 an imaging apparatus capable of operating in a still image mode and a moving image mode. The digital image capture apparatus (100) has an image-sensing element (114) that converts an optical image of an object passed through an optical transparent member (108) to an image signal (page 2, paragraphs 16-19). The apparatus (100) also includes a processing device (110) that performs moving image signal processing for near image data (170) and performs still image signal processing for distant image data (172) (page 2, paragraphs 19-23). The near image data (170) and distant image data (172) are obtained by adjusting the focal length of the optical system (108) to focus images of a near scene (102) or a distant scene (103) onto the sensor (114) at the focal plane of the optical system (page 2, paragraph 20; figs. 2,3). Therefore, when the apparatus is in the still image mode the optical transparent member (108) has a focal length within a range capable of focusing images of a distant scene (103) onto the image sensor and when the apparatus is in the moving image mode the optical transparent member (108) has a focal length within a

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range capable of focusing images of a near scene (102) onto the image sensor (114). Signal processing for the still image mode and the moving image mode is different in certain aspects. The encoding process for still image data may use a larger set of symbols than the encoding process for video image data because there may be more time allocated in the host/PC to decompress still images (page 4, paragraphs 42-43). The examiner is reading this feature as the signal-processing device performing a predetermined control (encoding a larger set of symbols having variable binary string lengths). Therefore, when still image signal processing is to be executed, the signal-processing device performs a predetermined control (encoding a larger set of symbols having variable binary string lengths) when the optical transparent member has a focal length within predetermined range of focal length (still image mode the optical transparent member (108) has a focal length within a range capable of focusing images of a distant scene (103)) and the predetermined control (encoding a larger set of symbols having variable binary string lengths) is not performed when moving image signal processing is to be executed.

Re claim 2, see claim 1. The near image data (170) and distant image data (172) are obtained by adjusting the focal length of the optical system (108) to focus images of a near scene (102) or a distant scene (103) onto the sensor (114) at the focal plane of the optical system (page 2, paragraph 20; figs. 2,3). Therefore, when the apparatus is in the still image mode the optical transparent member (108) has a focal length within a range capable of focusing images of a distant scene (103) onto the

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image sensor and when the apparatus is in the moving image mode the optical transparent member (108) has a focal length within a range capable of focusing images of a near scene (102) onto the image sensor (114). The encoding process for still image data may use a larger set of symbols than the encoding process for video image data because there may be more time allocated in the host/PC to decompress still images (page 4, paragraphs 42-43). Therefore, the signal-processing device does not perform the predetermined control (encoding a larger set of symbols having variable binary string lengths) when the optical transparent member does not have a focal length within a predetermined range of focal length (focal length range corresponding to still image mode).

Re claim 3, see claim 1. The still image signal processing is limited to the encoding process disclosed in claim 1 above.

Re claim 5, the still image data may be transferred over a bus (542) to a local storage device (122) such as a flash memory card (page 5, paragraphs 50-51).

Re claim 6, the recording process of the still image data is limited to transferring the data to either a local storage device (122) or to a host computer via a communication interface (154) (page 5, paragraphs 50-51).

Re claim 15, the digital image capture apparatus (100) has an optical transparent member (108) including a lens system (106) and aperture (104) (page 2, paragraph 16).

Re claim 16, see claim 15.

Re claim 21, see claim 1.

Re claim 22, see claim 2.

Re claim 24, see claim 15.

Re claim 25, see claim 15.

Re claim 32, see claim 1.

Re claim 34, see claim 1.

Re claim 38, Dunton discloses in figure 1 an imaging apparatus capable of operating in a still image mode and a moving image mode. The digital image capture apparatus (100) has an image-sensing element (114) that converts an optical image of an object passed through an optical transparent member (108) to an image signal (page 2, paragraphs 16-19). The apparatus (100) also includes a processing device (110) that



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performs moving image signal processing for near image data (170) and performs still image signal processing for distant image data (172) (page 2, paragraphs 19-23). The near image data (170) and distant image data (172) are obtained by adjusting the focal length of the optical system (108) to focus images of a near scene (102) or a distant scene (103) onto the sensor (114) at the focal plane of the optical system (page 2, paragraph 20; figs. 2,3). Therefore, when the apparatus is in the still image mode the optical transparent member (108) has a focal length within a range capable of focusing images of a distant scene (103) onto the image sensor and when the apparatus is in the moving image mode the optical transparent member (108) has a focal length within a range capable of focusing images of a near scene (102) onto the image sensor (114). Mode selection can be made by a user and a system controller (160) orchestrates the capture of images in both modes of operation in response to the mode selection made by the user (page 2, paragraphs 22-23). Therefore, it can be seen that optical property of the optical system is designed allowable for recording a moving image and not allowable for recording a still image when the user selects moving image mode. Additionally, when the moving image mode is selected the optical transparent member has a focal length within a predetermined range of focal length according to the moving mode (in the moving image mode the optical transparent member (108) has a focal length within a range capable of focusing images of a near scene (102)).

Re claim 40, see claim 1.

Re claim 42, see claim 1.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claim 14 rejected under 35 U.S.C. 103(a) as being unpatentable over  
Dunton et al. in view of Miyadera US 6,819,357.**

Re claim 14, Dunton discloses all of the limitations of claim 1 above. Although Dunton states that near image data (170) and distant image data (172) are obtained by adjusting the focal length of the optical system (108) to focus images of a near scene (102) or a distant scene (103) onto the sensor (114) at the focal plane of the optical system, he fails to disclose a detector for detecting the focal length of the optical transparent member.

Miyadera discloses in figures 1 and 2 a camera provided with a zoom lens (1) and a focal length detection device (3). When the focal length of the photographic lens (1) is varied, the focal length detection device (3) detects the varied focal length (col. 4,

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lines 3-15). Therefore, it would have been obvious for one skilled in the art to have been motivated to include the focal length detection device disclosed by Miyadera in the imaging apparatus capable of operating in a still image mode and a moving image mode. Doing so would provide a means for detecting the position of a movable lens group along the optical axis of an imaging device (Miyadera: col. 4, lines 14-16).

***Allowable Subject Matter***

Claims 4, 7, and 23 objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter: the prior art of record fail to anticipate or render obvious the following technical features as recited in the highlighted claims:

Referring to claim 4, the prior art fails to teach or suggest "...wherein said signal processing device inhibits said still image signal processing as said predetermined control".

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Referring to claim 7, the prior art fails to teach or suggest "...wherein said signal processing device inhibits said recording process of the still image signal as said predetermined control".

Referring to claim 23, the prior art fails to teach or suggest "...wherein said signal processing device inhibits said optical transparent member to move to said predetermined position as said predetermined limitation".

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Okamura (US 6,788,345) discloses an image pickup apparatus. The information regarding preventing the changing of focal length when recording a still image is pertinent material.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within

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TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

### ***Contacts***


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kelly L. Jerabek whose telephone number is 703-305-8659. The examiner can normally be reached on Monday - Friday (8:00 AM - 5:00 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wendy Garber can be reached on 703-305-4929. The fax phone number for submitting all Official communications is 703-872-9306. The fax phone number for submitting informal communications such as drafts, proposed amendments, etc., may be faxed directly to the Examiner at 703-746-3059.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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